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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,066	12/14/2001	Arthur B. Raitano	511582002410	7376
36327	7590	11/18/2003	EXAMINER	
AGENSY C/O MORRISON & FOERSTER LLP 3811 VALLEY CENTRE DRIVE, SUITE 500 SAN DIEGO, CA 92130			DAVIS, MINH TAM B	
			ART UNIT	PAPER NUMBER
			1642	
DATE MAILED: 11/18/2003				

13

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/017,066	RAITANO ET AL.
	Examiner MINH-TAM DAVIS	Art Unit 1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 16 August 2002.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 44-58 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) 44-58 are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \*    c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) Notice of References Cited (PTO-892)                            4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                    6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

It is noted that the numbering of the second claim 52 is not in accordance with 37 CFR 1.126. Misnumbered second claim 52 have been renumbered as 53.

Claims 44-58 are pending and subjected to the following restriction requirement.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

**Group 1.** Claims 44-50, drawn to:

- a) a nucleic acid encoding the polypeptide of SEQ ID NO:2, or variants thereof,
- b) a nucleic acid comprising the nucleic acid of claim 44 and control sequences, and recombinant cells modified to contain the nucleic acid of (b)
- c) a method for producing a PHOR-1 polypeptide,

classified in class 435, subclasses 69.1, 320.1, 325, and class 536, subclass 23.1.

**Group 2.** Claims 51-53, drawn to the polypeptide of SEQ ID NO:2 or variants thereof, classified in class 530, subclass 350.

**Group 3.** Claims 54-57, drawn to antibodies or fragments thereof, that specifically bind to the polypeptide of SEQ ID NO:2, classified in class 530, subclass 387.1.

**Group 4.** Claim 58, drawn to a method for detecting the concentration of a PHOR-1 polypeptide, classified in class 435, subclass 7.1.

The inventions are distinct, each from each other because of the following reasons:

Groups 2 and 4 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05 (h)). In this instant case, a polypeptide could be used for several purposes, e.g. for biochemical assay, for making antibodies, and for making an affinity column to purify its antibodies.

In addition, groups 3 and 4 are related as product and process of use. In this instant case, an antibody could be used for several purposes, e.g for immunoassay, for purification of its antigen.

Further, the product of group 1 is not related to the methods of group 4, because the polynucleotide of group 1 is not used in the method of group 4.

The products of groups 1-3 are patentably distinct, because they are drawn to entirely different biochemicals , having different structures, biological properties and activities.

Because these inventions are distinct for the reason given above and have acquired a separate status in the art, and further, because the searches for the groups are not co-extensive, and therefore, it would be a serious burden for the Examiner to examine all the groups and species together, restriction for examination purposes as indicated is proper.

Applicants are required under 35 USC 121 to elect a single disclosed group for prosecution on the merits to which the claims shall be restricted even though the requirement could be traversed.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 703-305-2008. The examiner can normally be reached on 9:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANTHONY CAPUTA can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.

Application/Control Number: 10/017,066  
Art Unit: 1642

Page 5



MINH TAM DAVIS

Patent Examiner

November 14, 2003